

REMARKS

Applicant has amended the specification to add claim of priority to an earlier filed application under 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(2)(ii)(B). A substitute specification and a redlined version of the specification are also enclosed. The substitute specification contains no new matter.

Section 1.78(a)(2)(i) of the Patent Rules states:

(2)(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America **must contain or be amended to contain** a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

The above-captioned application is a nonprovisional application and was filed prior to the issuance of the application to which it claims priority. Thus, at the time it was filed, it was copending with the prior-filed application to which it claims priority. Section 1.78(a)(2)(i) clearly allows for the application claiming priority to contain the reference to the earlier filed application, or be amended to contain the reference at a later time.

Section 1.78(a)(2)(ii)(B) states:

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely

submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

- (A) An application for a design patent;
- (B) An application filed under 35 U.S.C. 111 (a) before November 29, 2000; or
- (C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

Section 1.78(a)(2)(ii) states that the “reference must be submitted during the pendency of the *later-filed* application.” (Emphasis added). Section 1.78(a)(2)(ii) places additional time limitations on when an Applicant can amend to add the reference, but Section 1.78(a)(2)(ii)(B) clearly states that these limitations do not apply to an application filed under 35 U.S.C. 111(a) before November 29, 2000.

The above-captioned application was filed under 35 U.S.C. 111 (a) prior to November 29, 2000, was copending with the earlier filed application, and was amended to contain a proper reference to the earlier filed application in a timely manner. Accordingly, Applicant submits that its amendment to add claim of priority is proper under the Patent Rules and respectfully requests that Examiner enter same.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-3586. If prosecution would be advanced by a telephone conference with the undersigned, Applicant invites Examiner to contact the undersigned.

Respectfully submitted,

ASHOK V. JOSHI ET AL.

By their Representatives,

Date 1/23/2007

By 
David Fonda
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AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/649,563

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23 day of January, 2007.

David Forde

Name

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Signature